

PATENT

Attorney Docket No. A-63098-1/468250-00008/RFT/THR



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

n re application of:

LESTER *et al.*

Serial No.: 09/039,927

Filing Date: March 16, 1998

For: Inward Rectifier, G-Protein Activated,
Mammalian, Potassium Channels and Uses Thereof

Examiner: PAK, Michael D.

Art Unit: 1646

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on May 24, 2004

Signed:

Traci H. Ropp

Statement of the Substance of Interview under 37 CFR 1.133(b)

Mail Stop RCE
Commissioner for Patents,
P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In accordance with the requirements of 37 C.F.R. § 1.133(b) and M.P.E.P. § 713.04, Applicant hereby provides the following Statement of the Substance of Interview as a written summary of the recent telephone between Examiner Michael D. Pak and Applicants' attorneys Richard F. Trecartin and Traci H. Ropp in the above-identified application.

On April 29, 2004, Applicant's attorneys called Examiner Pak to discuss claims 18-24 of the present application. During the interview, the rejections of claims 18-24 under 35 U.S.C. § 112, Second Paragraph; 35 U.S.C. § 112, First Paragraph (written description); and 35 U.S.C. § 102(a) were discussed. The rejection of claims 18-20 under 35 U.S.C. § 102(b) was also discussed.

Applicant's attorneys and Examiner Pak discussed the definition of a Kir3.0 channel and how the terms Kir3.1, Kir3.2, Kir3.3 and Kir3.4 refer to polypeptides that make up the Kir3.0 channel. Applicant's attorneys provided additional support that one of skill in the art would

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understand the metes and bounds of the claims by showing that the classification of Kir3.0 subunits as Kir3.1, Kir3.2, Kir3.3 and Kir3.4 polypeptides has been adopted by the scientific community. Specifically, Applicant's attorneys cited Coetzee, et al., "Molecular Diversity of K⁺ Channels", Annals N.Y. Acad. Sci., 233-285 (1999), a copy of which is attached.

Examiner Pak suggested that the claims be amended to recite that the claimed polypeptides are 50% identical to specific Kir polypeptides that are structurally identified by amino acid sequence. Applicant's attorneys noted the Examiner's suggestion and stated that they would discuss the suggested amendments with the Applicant.


Examiner Pak cited similar concerns regarding the written description requirement and again suggested that the claims be amended to recite a specific sequence. Applicant's attorneys noted the Examiner's suggestion and stated that they would discuss the suggested amendments with the Applicant.

Examiner Pak stated that amendment of the claims to cite specific sequences may also be helpful in overcoming the pending 35 U.S.C. § 102(a) rejection of claims 18-24 over Duprat, et al. and the 35 U.S.C. § 102(b) rejection of claims 18-20 over Yatani, et al. with (evidence from Krapivinsky, et al.), and Karschin et al. (with evidence from Krapivinsky et al.).

Respectfully submitted,

DORSEY & WHITNEY LLP

Date: May 24, 2004


Richard F. Trecartin, Reg. No. 31,801

Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187
Telephone: (415) 781-1989

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